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Date:

May 22, 2006

To:

Examiner: Thomas Duong  
Art Unit: 2145

Location:

United States Patent and Trademark Office

Fax No.:

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From:

Attorney: Lawrence T. Cullen Reg. No. 44,489

Subject:

Serial No. 09/734,220 Filed: 12/11/2000 Docket No. D2487

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**MESSAGE:**

Enclosed herewith, please find Pre-Appeal Brief in response to the final office action mailed on February 23, 2006, Notice of Appeal, with fees due, for filing in the above-identified application.

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**EXAMINER:**

**Thomas Duong**

**GROUP ART UNIT:**

**2145**

**ATTORNEY DOCKET NO.:**

**D2487**

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Atty. Doc. No.: D2487

**MAY 22 2006**

**PATENT**  
IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Inventor: Marc W. Kauffman ) Confirmation No.: 5436  
                              )  
                              ) Customer No.: 000043471  
U.S. Serial No.: 09/734,220 )  
                              )  
Filed: December 11, 2000 ) Art Unit: 2145  
                              )  
                              ) Examiner: Thomas Duong  
                              )  
Title: SEAMLESS ARBITRARY DATA INSERTION FOR STREAMING MEDIA

**PRE-APPEAL BRIEF  
REQUEST FOR REVIEW**

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir,

Please enter these arguments in response to the Final Office Action mailed on February 23, 2006 and conduct a pre-appeal brief conference.

**CERTIFICATE OF FACSIMILE**

I hereby certify that this correspondence is being filed by facsimile to Assistant Commissioner for Patents at 571 273-

8300

on 5/22/06

by LTC

Lawrence T. Cullen

Atty. Doc. No.: D2487

## REMARKS

### I. Introduction

Claims 1-30 are pending in the above application.

Claims 1-30 stand rejected under 35 U.S.C. § 102.

Claims 1, 2 and 21 are independent claims.

### II. Rejections Under Prior Art

Claims 1-30 stand rejected under 35 U.S.C. § 102(e) as being unpatentable over Capek et al. (U.S. Pat. 6,094,677).

#### A. Capek Does Not Disclose All Of The Claimed Limitations

As explained in Applicant's prior responses filed on July 5, 2005, November 18, 2005, and April 24, 2006, Capek does not disclose or suggest inserting an alternative media file into a streaming multimedia file using a first and second cache, a control unit, and a switching mechanism, wherein the alternative media file is inserted in the stream independent of boundaries of the multimedia file, as substantially recited by amended claims 1 and 21.

Capek discloses a technique of providing mainly computer program products during retrieval delays in an interactive system. Capek, abs.; col. 6: 66 through col. 7: 16 ("The present invention takes advantage of retrieval delays in interactive systems ... For purposes of the present disclosure, the information provided to the user during the delays is referred to hereinafter as an insert or insertion"). Capek relies on an insertion manager 20 to receive a program request from a client, pass the request to a server containing insertions, and pass programs received from the server to the client. Capek, Fig. 2; col. 7: 47. If the time to retrieve the program from the server is excessive, the insertion manager

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retrieves an insertion from an insertion repository 22 during the delay. Capek, Fig. 2 and Fig. 3, steps 30, 32, 34 and 36.

More particularly, Capck discloses to determine if an insert should be provided based on the sufficiency of the delay period, which may be determined by the actual delay seen or an expected delay based on historical information. Col. 10: 52-68; and col. 11: 61 - col. 12: 24. Capek clearly explains this process, with reference to Figs. 4A (the prior art to Capek) and 4B (the implementation of Capek) as follows:

Accordingly, the present invention is able to provide an insertion of customized information to a client *during the retrieval* of requested program materials which, without the present invention, will be perceived as dead time to the client 24. This is graphically illustrated in FIGS. 4A and 4B which show the timing relationship between a system that does not implement the present invention (FIG. 4A) and a system which does implement the prcsent invention (FIG. 4B). Referring to FIG. 4A which does not implement the present invention, a client initiates a request at time A which is passed through the insertion mechanism at time B to the server 26 within the network 28 at time C. After a time delay, the server 26 begins to transmit the requested program material to the client 24 at time D. The beginning of the program material that was sent at time D ultimately arrives at the client 24 at time F. The server 26 continues to transmit the program material through time G and the requesting client continues to receive the program material until time I. As evident from FIG. 4A, the client experiences a delay from time A through at least time F, and possibly through time I. During the interval from time F to time I, the user may be presented with results depending upon the specific technology and specific content for that particular instance.

With the present invention, as illustrated in FIG. 4B, the insertion manager at time B **not only passes the request on to the server 26** but begins the process of the present invention which may include making certain determinations as to whether or not the delay may be sufficient to provide an insertion. This may include the initiation of a timer at time B to determine if insertion manager 20 receives a response from the server 26 within a predefined period of time. If the insertion manager 20 does not receive a response by time W, then the insertion manager 20 may respond by sending an insertion to the client 24 which may take from time W to time Y. The insertion is received at the client 24 from time X to time Z. Therefore, the client is presented with the insertion from at least time Z through time F, and perhaps from time X through time I, again depending upon the specific content and technology.

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Capek is clearly focused on delays in retrieving data from the server to the client.

Capek does not disclose or suggest inserting an alternative media file into a streaming multimedia file using a first and second cache, a control unit, and a switching mechanism, wherein the alternative media file is inserted in the stream independent of boundaries of the multimedia file.

#### B. The Examiner's Arguments Are Misplaced

In the Advisory Action, the Examiner alleges that Capek does disclose to insert an alternative media file in a stream independent of the boundaries of the multimedia file. Advisory Action, pg. 4-5. The Examiner points to four locations in Capek and attempts to establish the fact with an argument spanning an entire page and a half. The Examiner's reliance on each of the citations is misplaced. First the Examiner points to a "control mechanism" that "will provide for the replacement of the insertion by the requested program material once the program material is received from the distributed [sic] server", citing col. 9: 11-13. The fact that the insertion is replaced by the program the client originally requested from the server when it is received makes it clear that the boundaries of the program clearly are considered for the insertion of Capek. Also, contrary to the suggestions in the Advisory action, the discussion in the paragraphs spanning column 9 to column 10 of Capek, is clearly relying on a delay period in the data stream. The time periods discussed in Capek are related to retrieving an advertisement insertion from the server or the "second computer" to the client within the delay period. Col. 9: 54 through col. 10: 28 ("the determination of whether or not the delay will be sufficiently long may be based upon a variety of factors ...").

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Furthermore, the Capek also does not disclose using a control signal output from the cache which indicates that a complete alternative file is stored and is ready for transmission to the predetermined at least one end-user, or will be ready in time to transmit, as recited by claim 2, amended to be in independent form.

Accordingly, as Capek does not disclose or suggest each and every element of the pending claims and hence does not anticipate the pending claims.

### III. Conclusion

Accordingly, Applicant respectfully requests withdrawal of the rejections and allowance of the above application. To the extent an extension of time is needed for consideration of this response, Applicant hereby request such extension and, the Commissioner is hereby authorized to charge deposit account number 502117 for any fees associated therewith.

Date: 5/22/06

Respectfully submitted,

By: LTC

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